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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,301	04/23/2001	Irah H. Donner	114953.402US2	5047

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,301

Applicant(s)

DONNER, IRAH H.2

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Regarding the status of the claims in the instant application, the Examiner has found new prior art. The Examiner is obliged to apply the newly found prior art. The Examiner regrets the delayed process of the application. Accordingly, claims 15-55 remain pending in the application.

Claim Rejections - 35 USC § 112

2. Claims 15-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 15-55, it is unclear as to which steps of the claims the computer is being used to assist in performing a particular function of the claimed process or method.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 15-55 do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 15-55 are rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hough (US Patent No. 5,414,621).

As per claims 15, 21, 28, 34, 41, 42, 43, 48 and 55, Hough discloses a system and method for determining the value of a real estate property. See the abstract. The system and method comprise:

Storing first objectively determinable characteristics of representative of real estate properties and objectively determinable values corresponding to each of the representative real

estate properties, the first objectively determinable characteristics and the objectively determinable values forming a baseline against which to assess the estimated value of the real estate subject (column 4, lines 7-15 and line 57 to column 5, line 11);

Analyzing the real estate property subject to determine second objectively determinable characteristics of the real estate subject to be estimated,

Deriving first information representing the second objectively determinable characteristics of the real estate property to be estimated responsive to the analyzing step and

Retrieving second information representing the first objectively determinable characteristics and the objectively determinable values of the representative real estate properties (column 6, lines 5, lines 12-43 column 9, lines 5-32);

Comparing the first information received from the deriving step to the second information received from the retrieving step producing an estimated value of the real estate property portfolio when the first information of the real estate properties are statistically similar to the second information of one of the representative real estate properties (column 8, lines 34-63 and column 7, lines 43-60).

The only difference between the claimed invention and the teachings of Hough is the type of data being claimed. It is noted that the type of data does not affect the functioning of the system of Hough since in memory or computer manipulation, data is only data. The kind of data does not affect the functioning of the system. Thus, it would have been obvious to one of ordinary skill in the art to change the type of data so as to apply the principle or techniques applied in Hough in a desired type of environment in order to determine the value of a subject property such as an intellectual property.

As per claims 16, 29, Hough does not explicitly teach an intellectual property as indicated above. The Examiner notes that intellectual properties include patents, trademarks, trade secrets and copyrights. Having one of these types of data in the system of Hough would have been obvious to one of ordinary skill in the art at the time of the invention with the motivation noted above and also to widen the scope of Hough by estimating the value of a plurality of types of properties.

As per claims 17, 30 and 44, Hough discloses using one or more databases or sources of information in estimating the value of a real estate subject. See column 4, lines 32-35 and lines 57-62 of Hough. The Examiner notes that in determining the estimated value for an intellectual property, related information regarding the related intellectual property would have been sought after. Thus, one of ordinary skill in the art would have found it obvious to look for data regarding at least one of a patent database, a trademark database, a copyright database, a technical literature database, a legal reporter database, a current events database and an intellectual property. The motivation would have been to obtain data regarding intellectual in order to make a better assessment in estimating the value of the intellectual property.

As per claims 18, 31 and 45, claims 18, 31 and 45 are directed to the various attributes found in a patent or related to a patent. Hough also teaches taking into consideration various attributes such as the number of bedrooms, the neighborhood, age of the house, and other features and/or options related to a subject real estate property in determining its value. Applicant is directed to figures 12-13 and 15-16 of Hough.

As per claims 19, 32, 46, claims 19, 32 and 46 also contain attributes regarding to a property. As per the limitation of the “frequency with which the patents have been cited as references for other patents”, Hough discloses considering features of other real estate properties and which other kinds or similar properties were sold in estimating the value of a subject property. Applicant is directed to figures 15-16 and 18-19.

As per claims 20, 33 and 47, Hough teaches determining differences in value by weighing the values of the subject property and comparing such with the values of other properties and/or other recently sold properties.

As per claims 22, 35 and 49 Hough teaches the estimated value of the subject properties is derived substantially independent of accounting valuation techniques including cost, market and income approaches.

As per claims 23, 36 and 50, Hough teaches the first information is statistically similar to the second information of one of the representative real estate properties. See column 4, line 5 to column 7, line 60. Hough does not explicitly teach utilizing at least one of a curve fitting technique and a standard deviation technique. The Examiner asserts that a curve fitting technique or a standard deviation technique is well known in the art. Using any one of these well-known techniques would have been obvious to one of ordinary skill in the art to use in the system of Hough in order to determine a closest match between one property and the property being evaluated.

As per claims 24, 37 and 51, the objectively determinable values of the real estate properties include objectively determinable monetary values. See figures 12 and 15-18 of Hough.

As per claims 25, 38 and 52 note figures 12 and 15-18 of Hough.

As per claims 26-27, 39-40 and 53-54, note column 1, line 41 to column 2, line 49 and column 4, lines 5-49 of Hough.

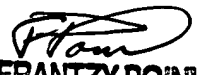
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FP
October 7, 2004


FRANTZY POINVIL
PRIMARY EXAMINER
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